

REMARKS

In response to the above-identified Office Action, Applicants seek reconsideration of the application. No claims have been canceled, twenty-nine claims have been added and one claim has been amended. Accordingly, Claims 1-36 are pending.

I. Claims 1 and 3 Rejected Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner has rejected Claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by Miyasaka (U.S. Patent No. 5,869,208). Applicant respectfully traverses this rejection.

It is axiomatic that to anticipate a claim, every element of the claim must be disclosed within a single reference. Thus, if even one feature of Claim 1 is not found in Miyasaka, Applicant respectfully requests withdrawal of the rejection of Claim 1 and 3 under 35 U.S.C. § 102.

Claims 1 and 3 recite a positive active material slurry composition that is prepared by physically mixing a positive active material, an additive and a binder in an organic solvent in a form of slurry. Applicant respectfully submits that Miyasaka does not teach or suggest physically mixing a positive active material, an additive and a binder in an organic solvent in a form of slurry.

In the Office Action, the Examiner contends that Miyasaka disclose a filler that includes organic solvents such as polypropylene and polyethylene. However, the passage referred to in Miyasaka (i.e., column 8, lines 43-48) merely indicates that “[e]xamples of the fillers are any fibrous materials which are chemically stable in the battery and includes fibers of olefin polymers such as polypropylene and polyethylene, glass material and carbonaceous. material.” There is nothing in Miyasaka that teaches or suggests physically mixing a positive active material, an additive and a binder in an organic solvent in a form of slurry.

Since Miyasaka does not disclose or suggest a positive active material slurry composition that is prepared by physically mixing a positive active material, an additive and a binder in an organic solvent in a form of slurry, Applicant respectfully submits that Claims 1 and 3 are not anticipated by Miyasaka and requests that the rejection of Claims 1 and 3 under 35 U.S.C. § 102(b) be withdrawn.

II. Claims 1-7 Rejected Under 35 U.S.C. § 103(a)

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikawa et al. (U.S. Patent No. 5,922,491) and further in view of Lu et al. (U.S. Patent No. 6,348,182). Applicant respectfully traverses this rejection.

Applicant respectfully submits that Claims 1 and 5 are not obvious over Ikawa in view of Lu.

In the Office Action, the Examiner correctly notes that Ikawa is silent to employing an organic solvent. However, the Examiner contends that Lu teaches that it is conventional to employ organic solvents in order to prepare lithium manganese oxide spinel structures.

In rejecting Claims 1 and 5, the Examiner argues that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the organic solvent of Lu in the electrode of Ikawa, because the secondary reference teaches that it is well known in the art to use organic solvents to aid mixing of electrode material.” However, it is not clear how the invention of Ikawa could be modified in accordance with the subject matter of Claims 1 and 5 because there is no suggestion or motivation in either Ikawa or Lu to physically mix a positive active material with a binder in an organic solvent to produce a positive active material composition in a slurry form, i.e., suitable for coating a current collector. Accordingly, Applicant respectfully submits that the Examiner has failed to meet its burden of proof to establish a prima facie

obviousness rejection under 35 U.S.C. §103(a) based upon the lack of motivation to combine the references and requests that the rejection of Claims 1 and 5 be withdrawn.

Moreover, to establish a prima facie case of obviousness, the cited references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the cited references, not in Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that even if Ikawa and Lu could be combined, the combination does not teach or suggest all the limitations of Claim 5.

Applicant respectfully submits that neither Ikawa nor Lu discloses or suggests a method in which a positive active material slurry composition is coated on a current collector, much less coating a current collector with a positive active material slurry composition that has been prepared in a form of slurry by physically mixing a lithiated transition metal, an additive, a binder, a conductive agent in an organic solvent.

Since neither Ikawa nor Lu discloses or suggests coating a positive active material composition (prepared according to Claim 5) on a current collector and drying the current collector coated with the positive active material slurry composition, Applicant respectfully submits that, even if Ikawa and Lu could be combined, the combination would not render Claim 5 obvious. Applicant therefore respectfully requests that the rejection of Claim 5 be withdrawn.

In view of the foregoing, Applicant respectfully submits that Claims 1 and 5 are not obvious over Ikawa in view of Lu and requests withdrawal of the rejection of Claims 1 and 5. Dependent Claims 2-4, 6 and 7 are submitted as not being obvious in view of the relied upon references at least for the reasons given in support of their base Claims 1 and 5.

III. New Claims 8-36

Applicant respectfully submits that New Claims 8-36 are supported by the original disclosure. With respect to New Claims 8-36, Applicant incorporates its prior arguments with respect to their base Claims 1 and 5. Therefore, Applicant is of the opinion that New Claims 8-36 are allowable over the cited references.

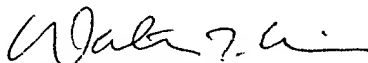
CONCLUSION

In view of the foregoing, it is submitted that the claims are in condition for allowance. Reconsideration of the rejections and objections is requested. Allowance is earnestly solicited at the earliest possible date. If there are any fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: June 12, 2002

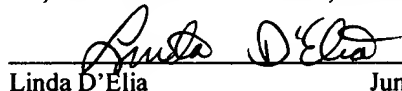


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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box AF, Commissioner for Patents, Washington, D.C. 20231 on June 12, 2002.



Linda D'Elia

June 12, 2002

Attachment: Version With Markings To Show Changes Made



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

The claims have been amended as follows:

1. (Amended) A positive active material slurry composition comprising:
a physical mixture of
a positive active material comprising a lithiated transition metal compound, and
an additive selected from the group consisting of semi-metals, metals and oxides thereof;
a binder; and
an organic solvent, wherein said positive active material composition is prepared
by physically mixing said positive active material, said binder in said organic solvent in a
form of slurry.

New claims 8-36 have been added.

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